OIPE JC82
JAN 22 2003
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: G. I. Negueloua DATE: January 14, 2003

SERIAL NO: 09/784,693 GROUP ART UNIT: 3671

FILED: 02/15/2001 EXAMINER: Hartmann, Gary S.

FOR: "Improved Cap Sealer for Caulked Joints"

ATTORNEY DOCKET NO.: A00360US (98448.2)

* *

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

BRIEF OF APPELLANT

RECEIVED
JAN 3 1 2003
GROUP 3600

Board of Patent Appeals and Interferences
Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sirs:

On August 9, 2002, the Examiner finally rejected Claims 1-12 of the above-referenced patent application. A Notice of Appeal was filed on October 6, 2002, and was received by the USPTO on October 15, 2002. This brief, required by 37 C.F.R. § 1.192(a), is due on January 15, 2003 (see 37 C.F.R. § 1.8(a)(2) and MPEP § 512, last paragraph on pages 500-35 (6th ed., Rev. 1, Sept. 1995)); it is in the form required by 37 C.F.R. § 1.192(c).

CERTIFICATE OF MAILING

I hereby certify that **the original and two copies** of this Appeal Brief are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on January 15, 2003.

Gregory C. Smith, Reg. No. 29,441

01/28/2003 EAREGAY1 00000017 09784693
01 FC:2402 160.00 OP

RECEIVED
2003 JAN 22 AM 10: 39
BOARD OF PATENT APPEALS AND INTERFERENCES

(1) REAL PARTY IN INTEREST:

G. I. Negueloua

(2) RELATED APPEALS AND INTERFERENCES:

None

(3) STATUS OF CLAIMS:

Claims 1 through 12 have were rejected under 35 U.S.C. § 103, as being unpatentable over U. S. Patent No. 2,016,968 (Marble Patent) in view of U.S. Patent No. 5,857,802 (Richter Patent)

The rejection of Claims 1 - 12 is being appealed.

(4) STATUS OF AMENDMENTS:

An amendment was filed on July 8, 2002, and was entered.

(5) SUMMARY OF INVENTION:

As suggested by MPEP § 1206, Applicant has read some of the appealed claims on the specification and drawings. These claims follow.

1. An improved cap (10) for sealed joints between adjacent blocks (30,32), comprising:

a) a flexible body member (12), comprising a first cap portion(14) and a leg portion(16);

b) a plurality of ridges (22) positioned on an underside (18) cap portion (14), having a plurality of channels (24) there between, the ridges (22) further defining an increased area on the underside of the cap (14)for sealant (38) to adhere to;

c) the leg portion (16) insertable into fluidized sealant material (38) within the joint (37) between the adjacent blocks (30,32), to a depth so that the underside of the cap portion imbeds into the sealant material (38) for providing a sealed connection between the underside (18) of the cap (14) and the fluidized sealant material (38) residing in the joint (34) and on an upper surfaces of the adjacent blocks (30,32).

2. The improved cap (10) in claim 1, wherein the cap (14) is constructed of material having the characteristics of lead.

3. The improved cap (10) in claim 1, wherein the leg member (16) further comprises a pointed end (28) having shoulder members (29,30) for adhering within the sealant material (38.)

4. The improved cap (10) in claim 1, wherein the plurality of ridges (22) and channels (24) on the underside of the cap portion (14) define a means for adhering to the fluidized sealant (38) and

the upper portion (31) of the adjacent blocks for withstanding movement and preventing damage to the sealed joint.

5. The improved cap (10) in claim 1, wherein the cap (14) may be positioned to seal a joint between horizontal and vertical surfaces.

6. An improved cap (10) for sealed joints between adjacent building members (31,32), comprising:

a) a flexible body member (12), comprising a first cap portion (14) having a first smooth upper surface (20), an undersurface (18), and a leg portion (16) extending down from the undersurface (18);

b) a plurality of ridges (22) positioned on the undersurface (18) of the cap portion (14), defining a plurality of channels (24) there between, the plurality of ridges (22) and channels (24) increasing the surface area on the underside (18) of the cap (10) by around 50% for the sealant (38) to adhere to, thus strengthening the seal between the cap (14) and the concrete or stone blocks (30,32) the cap (14) is set upon;

c) fluidized sealant material (38) placed within the joint between the adjacent building members (30,32) ;

d) the leg portion (16) insertable into the fluidized sealant material (38) to a depth so that the underside (18) of the cap portion (14) imbeds into the sealant material (38) for providing a sealed connection between the underside (18) of the cap (14) and the fluidized sealant material (38) residing in the joint and on surfaces of the adjacent blocks (30,32) .

7. The improved cap (10) in claim 6, wherein the sealant material (38) comprises caulking.

8. The improved cap (10) in claim 6, wherein the underside (18) of the cap (14) increases the area for the sealant (38) to adhere to, improving bonding between the cap (10) and the stones and strengthening the seal between the two.

9. The improved cap (10) in claim 6, wherein the cap (10) comprises a continuous strip of flexible material extending uninterrupted over the joint which needs to be sealed.

10. A method of sealing a joint between adjacent building blocks (30,32), comprising the following steps:

a) filling the joint with a fluidized sealing material (38) such as caulking (38) ;

b) providing a cap (10) , the cap (10) having a cap portion (14) and a downward depending leg portion (16) ;

c) inserting the leg (16) portion down in to the fluidized sealing material (38) to a point that an underside (18) of the cap (14) portion makes sealing contact with the fluidized sealing material (38) ;

d) providing a plurality of ridges (22) , which define a plurality of channels (24) there between on an underside (18) of the cap portion (14) , the ridges (22) and channels (24) increasing the area on the underside (18) of the cap (10) for the sealant (38) to adhere to, improving the bond between the cap (10) and the stones (30,32) and strengthening the seal between the two.

11. The method in claim 10, further comprising the step of removing the excess sealant material (38) from around the cap (10) before the sealant (38) completely sets.

12. The method in claim 10, the insertion of the leg portion (16) of the cap (10) down into the sealing material (38) decreases the size of a joint by one half therefore defining two joint spaces, rather than a single space.

(6) ISSUES:

(i) Are claims 1 - 12 patentable over U. S. Patent No. 2,016,968 and U.S. Patent No. 5,857,802 under 35 U.S.C. § 103?

(7) GROUPING OF THE CLAIMS:

The rejected claims do not stand or fall together. Based on the references cited and arguments made by the Examiner, the claims are grouped together in particular combinations in part (8) for convenience. Applicant reserves the right to regroup the claims or to argue the patentability of each claim individually should new references be cited or new arguments or rejections be made.

(8) ARGUMENT:

Claims 1 - 12 are patentable over U. S. Patent No. 2,016,968 and U.S. Patent No. 5,857,802 under 35 U.S.C. § 103.

Claims 1 - 12 were rejected under 35 U.S.C. § 103 as being unpatentable over U. S. Patent No. 2,016,968 and U.S. Patent No. 5,857,802. Applicant respectfully traverses this rejection.

It is clear that the Marble patent teaches the use of bonding material between adjacent building blocks which are subject to expansion and erosion. However, Marble failed to address the movement of the entire joint on a different plane. The Examiner, however, noted that although the Marble patent disclosed a cap adjacent blocks with sealant material, Marble did not teach or suggest the ridges to increase the bonding area by 50% on the underside of the cap portion, which greatly improves the ability of the cap to protect the joints. Column1, line 36 of Marble states "The plastic bonding materials or joint fillers now used..." The use of plastic or other types did not allow adherance to the surface until modern sealants were developed. The use of the ridges as claimed in applicant's invention, allows the cap to become an integral part of the joint, and not merely rest on top of the joint. This allows for not only expansion and contration, but also movement of the entire joint in a different plane. Without the ridges, the caps pulled away from the stone. The Marble patent prevented water intrusion caused by expansion and contraction of the bonding material. The fact that the present invention teaches elasticity, rather than a plastic member, allows it to integrally adhere to the joint and expand and contract with the joint.

In order to attempt to show this particular component, the Examiner cited the patent to Richter in combination with Marble. First, Richter is non-analogous art and therefore an improper reference. The Richter patent concerns reflectors studs for roads, and is not at all related to or suggestive of the present invention..

It is well known in the case law that for art to be analogous art, it must at least suggest the invention, which this does not. In re Oetiker, 977 F. 2d 1443, 24 USPQ 2d 1443, 1445 (Fed. Cir. 1992), stands for the proposition that "...a prior art reference must either be in the field of applicant's endeavor, or if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as the basis for rejection of the claimed invention." For that reason alone, Richter should be withdrawn

Morever, the reason that the Examiner has cited Richter is not taught or suggested by the Richter reference. Although the Examiner noted that Figure 2 in Richter taught ridges on a cap-pavement connection in order to improve adhesion therebetween. The only portion of the

specification which makes reference to Figure 2 states: "As best shown in FIG. 2, in the bottom surface 14.3 of space 14, there are also defined threaded holes 30. In use, bolts 32 may be threaded into the blocks 30 to serve as additional anchors for the markers 10 on the road or pavement structure." However, nothing in the Richter patent would teach the ridges as claimed in the present invention for increasing the surface area on the underside of the cap for the sealant to adhere to. There is no sealant feature in Richter which would have this particular structure necessary in order to carry out the device as taught in the Richter patent.

U. S. Patent No. 2,016,968 and U.S. Patent No. 5,857,802 merely show that some elements of the claimed invention are old. "That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art." Environmental Designs, Ltd. v. Union Oil Co., 218 USPQ 865, 870 (CAFC 1983). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under [35 U.S.C.] Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems v. Montefiore Hospital, 221 USPQ 929, 933 (CAFC 1984) and cases cited therein (emphasis in original). Applicant has carefully examined these patents, and can find neither teaching nor suggestion why it would be obvious to combine U. S. Patent No. 2,016,968 and U.S. Patent No. 5,857,802 to reach applicant's invention.

Thus, "[t]here is nothing in the prior art references, either singly or in combination, 'to suggest the desirability, and thus the obviousness,' of designing" an improved cap for sealed joints between adjacent blocks having a flexible body member which comprises a first cap potion and a leg portion; a plurality of ridges positioned on an underside cap portion, having a plurality of channels there between, the ridges further defining an increased area on the underside of the cap for sealant to adhere to; and the leg portion insertable into fluidized sealant material within the joint between the adjacent blocks, to a depth so that the underside of the cap portion imbeds into the sealant material for providing a sealed connection between the underside of the cap and the fluidized sealant material residing in the joint and on an upper surfaces of the adjacent blocks, or a method of

applying same. In re Deminski, 230 USPQ 313, 315 (CAFC 1986) and cases cited therein (emphasis in original). It is therefore respectfully submitted that independent claims 1, 7 and 10 are allowable, and likewise the dependent claims which are depending off allowable independent claims.

CONCLUSION:

For the foregoing reasons, applicant respectfully submits that all claims in the application are allowable. A Notice of Allowance is hereby respectfully requested.

TELEPHONE CONFERENCE INVITATION:

Should the Examiner or any member of the Board feel that a telephone conference would advance the prosecution of this application, he is encouraged to contact the undersigned at the telephone number listed below.

PETITION FOR EXTENSION OF TIME:

Applicant hereby petitions the Commissioner under 37 C.F.R. § 1.136 for any extension of time necessary to render this Appeal Brief timely filed, and asks that the fee for any such extension be charged to Deposit Account No. 50-0694.

FEES:

A $ 160.00 check for the fee required by 37 C.F.R. § 1.192(a) and § 1.17(f) is enclosed. Please charge any additional fees due or credit any overpayment to Deposit Account No. 50-0694.

Respectfully submitted,

Gregory C. Smith, Reg. No. 29,441
Seth M. Nehrbass, Reg. No. 31,281
Charles C. Garvey, Jr., Reg. No. 27,889
Stephen R. Doody, Reg. No. 29,062
Brett A. North, Reg. No. 42,040
GARVEY, SMITH, NEHRBASS & DOODY, L.L.C.
3838 N. Causeway Blvd., Suite 3290

Metairie, LA 70002
Tel.: (504) 835-2000
Fax: 504-835-2070
e-mail: IPLNO@AOL.COM
www.neworleanspatents.com

P:\2002\98448.2.app.brief.wpd

(9) APPENDIX:
CLAIMS ON APPEAL:

1. An improved cap for sealed joints between adjacent blocks, comprising:

a) a flexible body member, comprising a first cap portion and a leg portion;

b) a plurality of ridges positioned on an underside cap portion, having a plurality of channels there between, the ridges further defining an increased area on the underside of the cap for sealant to adhere to;

c) the leg portion insertable into fluidized sealant material within the joint between the adjacent blocks, to a depth so that the underside of the cap portion imbeds into the sealant material for providing a sealed connection between the underside of the cap and the fluidized sealant material residing in the joint and on an upper surfaces of the adjacent blocks.

2. The improved cap in claim 1, wherein the cap is constructed of material having the characteristics of lead.

3. The improved cap in claim 1, wherein the leg member further comprises a pointed end having shoulder members for adhering within the sealant material.

4. The improved cap in claim 1, wherein the plurality of ridges and channels on the underside of the cap portion define a means for adhering to the fluidized sealant and the upper portion of the adjacent blocks for withstanding movement and preventing damage to the sealed joint.

5. The improved cap in claim 1, wherein the cap may be positioned to seal a joint between horizontal and vertical surfaces.

6. An improved cap for sealed joints between adjacent building members, comprising:

a) a flexible body member, comprising a first cap portion having a first smooth upper surface, an undersurface, and a leg portion extending down from the undersurface;

b) a plurality of ridges positioned on the undersurface of the cap portion, defining a plurality of channels there between, the plurality of ridges and channels increasing the surface area on the underside of the cap by around 50% for the sealant to adhere to, thus strengthening the seal between the cap and the concrete or stone blocks the cap is set upon;

c) fluidized sealant material placed within the joint between the adjacent building members;

d) the leg portion insertable into the fluidized sealant material to a depth so that the underside

of the cap portion imbeds into the sealant material for providing a sealed connection between the underside of the cap and the fluidized sealant material residing in the joint and on surfaces of the adjacent blocks.

7. The improved cap in claim 6, wherein the sealant material comprises caulking.

8. The improved cap in claim 6, wherein the underside of the cap increases the area for the sealant to adhere to, improving bonding between the cap and the stones and strengthening the seal between the two.

9. The improved cap in claim 6, wherein the cap comprises a continuous strip of flexible material extending uninterrupted over the joint which needs to be sealed.

10. A method of sealing a joint between adjacent building blocks, comprising the following steps:

a) filling the joint with a fluidized sealing material such as caulking;

b) providing a cap, the cap having a cap portion and a downward depending leg portion;

c) inserting the leg portion down in to the fluidized sealing material to a point that an underside of the cap portion makes sealing contact with the fluidized sealing material;

d) providing a plurality of ridges, which define a plurality of channels there between on an underside of the cap portion, the ridges and channels increasing the area on the underside of the cap for the sealant to adhere to, improving the bond between the cap and the stones and strengthening the seal between the two.

11. The method in claim 10, further comprising the step of removing the excess sealant material from around the cap before the sealant completely sets.

12. The method in claim 10, the insertion of the leg portion of the cap down into the sealing material decreases the size of a joint by one half therefore defining two joint spaces, rather than a single space.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Board of Patent Appeals and Interferences Commissioner of Patents and Trademarks, Washington, D.C. 20231, on January 15, 2003.

Gregory C. Smith, Reg. No. 29,441